

4 digitally stored sounds selectable for individual replay, in order to expand the library of prerecorded  
5 sounds available for selectable replay by adding its library of prerecorded sounds to the library of the  
6 digital sound relaxation device, said collectable sound card having (1) a digital memory in which a  
7 plurality of prerecorded sounds are digitally stored for selectable replay and (2) a connector member for  
8 connection with said digital sound relaxation device.

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18. (new) The improved-customizability digital sound relaxation system of claim 17, further including  
2 a digital sound relaxation device having (1) an internal digital memory in which are digitally stored a  
3 plurality of prerecorded sounds for individual replay, (2) a connector member for connection with said  
4 connector member of said collectable sound card, and (3) a digital controller having operator input means  
5 and operative in response to at least one operator input in a sound card mode, where said collectable sound  
6 card is mated with said digital sound relaxation device, to replay a selected one of the plurality of  
7 prerecorded sounds stored on either of said digital memory of said collectable sound card or of said  
8 internal digital memory of said digital sound relaxation device, and operative in response to at least one  
9 operator input in a stand-alone mode, where said collectable sound card is not mated with said digital  
10 sound relaxation device, to replay a selected one of the plurality of prerecorded sounds stored on said  
11 internal digital memory of said digital sound relaxation device.

#### REMARKS

By the above-identified office action, claims 1-13 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting, allegedly in that the scope of claims 1-13 "reads on" that of the claims 1-14 of copending US utility application 08/706,134 of the same inventive entity as herein; claims 5-9 and 11-12 have been rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention, alleging as the grounds of indefiniteness, that certain language in the claim 5, in the claims 8 and 11, and in the claims 9 and 12 is "confusing"; claims 1-13 have been rejected under 35 USC 103 as obvious over Marsona 1250 in view of Inoue et al.; and the examiner has taken judicial notice that "audio signals stored in a loop format or a sound bit format are well known in the art and therefore would have been obvious" in rejecting the claims 8-9 and 11-12 as obvious over Marsona 1250 in view of Inoue et al..

By the instant amendment, the specification has been amended at page 2, line 32, to conform the specification to the description of the Marsona 1250 product brochure, and it has been amended at pages and lines 10,12; 11,6; 16,22; and 20,30 to correct readily apparent spelling and grammatical errors. Claims 5,8,9,11, and 12 have been amended to overcome the 35 USC 112, second paragraph, rejection and to better define the instant invention, specifically (1) deleting the allegedly confusing language of claim 5, (2) amending "the same" to "said" in claims 8 and 11, and (3) amending "pluralities" to "groups" in the claims 9 and 12; and new claims 14-18 have been added to further define the instant invention. The applicants believe the amended claims now conform to 35 USC 112, second paragraph, rendering further discussion of the 112 rejection moot, but invite further discussion of ambiguities that may remain. The new independent claims 14, 15, and 17 are respectively drawn to the same inventive aspects as originally filed independent claims 1, 5, and 10, namely, a combination collectable sound card and matable digital sound relaxation system; a digital sound relaxation system matable with a collectable sound card; and a collectable sound card matable with a digital sound relaxation system. No new matter has been entered.

#### The Traversal of the Provisional Obviousness Double-Patenting Rejection

MPEP section 804 sets forth that obviousness double-patenting rejections should set forth (1) the differences between the inventions defined by the allegedly conflicting claims of the copending applications, and (2) the reasons why a person skilled in the art would conclude that the inventions of the allegedly conflicting claims are obvious variations. However, the provisional obviousness double-patenting rejection of record does not comply with MPEP section 804. The mere allegation that the scope of the claims 1-13 of the instant application "reads on" that of the claims 1-14 of the cited application neither sets forth what (1) the differences are between the inventions defined by the allegedly conflicting claims of the copending applications, nor (2) any reasons why a person skilled in the art would conclude that those differences are merely obvious variations. Since the reasons alleged thus fail to state a *prima facie* obviousness double-patenting rejection, it is respectfully submitted that the obviousness double-patenting rejection be reconsidered and withdrawn, and that it need not be further discussed. (It may be noted, however, that although the above-captioned invention and that of the cited application share the same specification, the summary of the invention sections differ to reflect the different inventions claimed therein, and their claims have been carefully drafted to be readily patentably distinct in form and substance. The independent claims 1, 5, 10, 13, as originally filed and as now amended, and the independent claims 14, 15 and 17 as now amended, of the above-captioned application, are drawn to an improved-customizability digital sound relaxation system, and call for the above-outlined inventive aspects of a

collectable sound card that mates with a digital sound relaxation device to allow a user to customize its collection of available sounds. The independent claims 1 and 8 of US utility patent application serial number 08/706,134 as originally filed are drawn to an improved-flexibility digital sound relaxation system, and call for various inventive aspects of a digital sound relaxation system that permits a user to select any at least two (2) prerecorded sounds of a library of individual prerecorded sounds for concurrent replay, and to replay the any at least two (2) selected prerecorded sounds concurrently, thereby enabling the user to tailor playback in accord with their individual tastes and personal preferences. MPEP section 806.05(d) states that where, as here, two or more claimed subcombinations are disclosed as usable together in a single combination, which can be shown to be separately usable, the two inventions are usually patentably distinct from each other. Rather than being obvious variants of the same invention, the independent claims drawn to the inventive aspects of the collectable sound card and/or digital sound relaxation device adapted to mate with a collectable sound card to expand the available library of prerecorded sounds subcombinations of the improved-customizability digital sound relaxation system of the above-captioned invention, and the independent claims drawn to the inventive aspects of the digital sound relaxation device that allows a user to select in accord with individual preference and personal taste any two individual prerecorded sounds of a library of individual prerecorded sounds and to simultaneously replay any two selected individual prerecorded sounds subcombination of the cited application, are, as should thus be readily apparent, both patentably distinct and separately useable. As such, they are believed to properly have been presented in separate applications. It may also be noted that MPEP 804 provides that the rationale for the obviousness double-patenting rejection is based on a judicially created doctrine grounded in public policy to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. But even if an obviousness double-patenting rejection properly did lay in the instant matter, which it does not, the fact that the allegedly conflicting applications of the same inventive entity have the same filing date would result in two patents of the same term, so that no impermissible timewise extension would in fact result.)

The applicants accordingly respectfully request that the obviousness double-patenting rejection be reconsidered and withdrawn.

#### The Traversal of the 103 Rejection of Claims 1-13

The Marsona 1250 product brochure discloses a digital sound relation device having a plurality of built-in sounds available for selectable replay. To relax and/or to mask unwanted noise, a user of the

Marsona 1250 device selects one of the available sounds for replay, such as the Rain sound, by depressing the button marked "R1," and then listens to the sound selected so that it may work its intended masking, calming and soothing effects. However, the only sounds that are available for replay are the sounds built-in to the Marsona 1250 device, and, beyond the implicit suggestion to buy another separate sound relaxation device that may have the desired sounds built-in, no other provision is made therein to allow the user to expand its library of prerecorded sounds.

The Inoue et al. patent is drawn to a digital music synthesizer or instrument that, like any other musical instrument, is operated by a person with special skills to create music. Since such a digital music synthesizer or instrument operated by a person with special skills to create music solves a different problem than that of the digital sound relaxation devices exemplified by the Marsona 1250 type of devices, whose users passively select and listen to a prerecorded sound in order to mask background noise and/or to be soothed and calmed thereby, it is respectfully submitted that it is drawn from non-analogous art, and, therefore, may not properly be combined with the Marsona 1250 device in rejecting the claims of the instant invention under 35 USC 103. For these reasons, it is respectfully requested that the 103 rejection of claims 1-13 as obvious over Marsona 1250 and Inoue et al. be reconsidered and withdrawn.

Furthermore, there is no reason to be found in the combined references explicitly or implicitly suggesting their combination. The inventive aspects of the Inoue et al. digital music synthesizer or instrument call for a variable delay circuit generating a delay output tone signal that in two embodiments imparts a decay envelope and a rise envelope in order to prevent the generation of an undesirable "click" noise when the delay length is to be changed to effect a desired musical characteristic to the music being played thereon, and in another embodiment sequentially changes the delay length from the delay length before the change to the delay length after the change. Since the Marsona 1250 device is not a digital music synthesizer or instrument operated by a person with special skills to create music but is only capable of replay of its prerecorded sounds one at a time by an essentially passive user, which sounds are always reproduced thereby exactly as they were prerecorded without any possibility of distortion during replay, and because the three embodiments of Inoue et al. prevent click noise in a real-time digital music synthesizer precisely when it is being played in such a way as to impart desired musical characteristics, no suggestion in fact can be found therein warranting their combination. For these additional reasons, it is respectfully submitted that impermissible hindsight alone suggested their combination and it is

accordingly respectfully requested that the 103 rejection of claims 1-13 as obvious over Marsona 1250 and Inoue et al. be reconsidered and withdrawn.

In addition, even if the references were combined, for which no suggestion can be found from the combined references, the combination would not render the inventive aspects called for by the independent claims of the instant invention obvious. Rather than render the inventive aspects of the independent claims of the instant invention obvious, the incorporation of the variable delay embodiments of the Inoue et al. music synthesizer actively played by an operator to impart "click" noise free musical characteristics to music being played thereby would serve no useful purpose whatsoever in the Marsona 1250 digital sound relaxation device passively activated by a user to reproduce prerecorded noise masking and/or soothing sounds. Since Marsona 1250 is a passive device wholly unconcerned with the problem of providing click-free music generation while adding musical effects in a digital music synthesizer, so to modify it, which could serve no useful purpose whatsoever, would in any event not render the instant invention obvious. Accordingly, it is respectfully submitted that the combination of Marsona 1250 and Inoue et al. does not render the instant invention obvious, and for these additional reasons, it is respectfully requested that the 103 rejection of claims 1-13 as obvious over Marsona 1250 and Inoue et al. be reconsidered and withdrawn.

Moreover, the memory 12 of Inoue et al. is internal to the Inoue et al. digital music synthesizer and is operated to provide variable delay when the operator wishes to impart musical effects. Since the memory 12 of Inoue et al. is internal to the Inoue et al. digital music synthesizer and is operated to provide such variable delay as to prevent click noise when generating such real-time musical effects, the characterization thereof that "Inoue teaches that using sound card as external memory in an audio system is well known in the art (see 12) and therefore would have been obvious so that external data could have been accessed by the micro-controller" must be respectfully traversed, and it is respectfully requested that for these additional reasons alone the 103 rejection of claims 1-13 as obvious over Marsona 1250 and Inoue et al. be reconsidered and withdrawn.

For the foregoing reasons, it is respectfully submitted that the combination of Marsona 1250 in view of Inoue et al. does not render the inventive aspects called for by the independent claims 1, 5, 10, 13, 14, 15, and 17 obvious but rather that the independent claims 1, 5, 10, 13, 14, 15, and 17 are quite readily patentably distinguishable thereover. Accordingly, further discussion of the 103 rejection is

believed to be rendered moot. It may be noted, however, that the applicants continue to believe that the "sound bite" format as recited in the dependant claims 9, 12, as well as in the independent claim 13, is novel and unobvious over the prior art. As pointed out in the specification at pages 15 and 16, among other places, the claimed sound-bite format permits both random selection and random insertion playback of each of the multiple, complete-in itself versions of the same intermittent-type sound selected, which technique is particularly adapted to effectively simulate certain natural sounds. In this way, nature is better replicated, producing a degree of soothing and calming effects not heretofore possible.

The applicants have reviewed the art cited but not applied and believe the claims 1-13, as originally filed and as now amended, and the new claims 14-18, to be readily patentably distinguishable thereover.


For the foregoing reasons, claims 1-18 are now believed to be in readily allowable condition. Reexamination, reconsideration and early allowance thereof are accordingly respectfully requested.

The applicants appreciate the examiners detailed consideration of the instant application and invite the examiner to telephone the undersigned attorney to discuss any question or other matter that could help to facilitate the further prosecution, and early allowance, of the instant application.

Respectfully submitted,

RUDY A. VANDENBELT ET AL.

By:

  
Albert Peter Durigon  
Registration No. 30,049  
Attorney for Applicants

Law Offices  
Albert Peter Durigon  
20 Eustis Street  
Cambridge, Massachusetts 02140-2387  
617-354-7330 (Telephone)  
617-497-0229 (Telecopier)  
durigon@ix.netcom.com (E-mail)